

1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

VIOLET BLUE,

No. C 07-05370 SI

7 v. Plaintiff,

**ORDER RE: PLAINTIFF'S MOTION TO
STRIKE OR DISMISS DEFENDANT'S
COUNTERCLAIMS AND PLAINTIFF'S
MOTION FOR SANCTIONS**

8 ADA MAE JOHNSON, aka ADA
WOFFINDEN, dba VIOLET BLUE, aka
9 VIOLET aka VIOLET LUST,
Defendant..

II || AND RELATED COUNTERCLAIMS

14 On April 4, 2008, the Court heard argument on plaintiff's motion to strike and dismiss several
15 of defendant's counterclaims, as well as plaintiff's motion for sanctions. Having considered the
16 arguments of counsel and the papers submitted, and for good cause shown, the Court hereby DENIES
17 IN PART and GRANTS IN PART plaintiff's motion to strike and dismiss, and DENIES plaintiff's
motion for sanctions and defendant's cross-motion for sanctions.

BACKGROUND

Plaintiff and counterclaim defendant Violet Blue is a “well-known and respected personality in the field of human sexuality, sexual health, and relationship education” who has worked as a “writer, lecturer, blogger, podcaster, editor, and newspaper columnist.” Amended Complaint at ¶ 17. Since 1999, Blue has regularly written articles in various media under her own name. *Id.* at ¶ 18. Defendant and counterclaim plaintiff Ada Mae Woffinden is an actress who has appeared in dozens of pornographic films. *Id.* at ¶ 28. Woffinden has appeared in many adult films under the name “Violet Blue.” *Id.* Sometime in late October 2006, plaintiff Blue received several communications from other journalists and acquaintances indicating that they believed she would be appearing at the Exotic Erotic

1 Ball the weekend of October 28, 2006 in South San Francisco. *Id.* at ¶ 54. Blue soon learned that
2 Woffinden was scheduled to appear at the Exotic Erotic Ball under the name “Violet Blue.” *Id.* Blue
3 alleges other instances of confusion as well, such as when pornographic actor “Dave Pounder” emailed
4 Blue at the San Francisco Chronicle thinking she was Woffinden, with whom “Pounder” had acted in
5 his first “scene.” *Id.* at ¶ 56. On October 22, 2007, Blue filed a complaint for trademark infringement,
6 trademark dilution, violation of California Civil Code § 3344, and unfair competition.

7 Blue filed an amended complaint on February 4, 2008, and on the same day Woffinden filed her
8 second answer. The answer included five counterclaims, including claims for declaratory relief,
9 cancellation of Blue's trademark application, trademark infringement, and outrage. The fifth
10 counterclaim, for outrage, arose out of comments Blue made about Woffinden on Blue's blog around
11 October 26, 2007, when Blue learned that Woffinden would be appearing at the Exotic Erotic Ball under
12 the name "Violet Blue." Woffinden claims that Blue called her a "twat," Answer at 27, ¶ 17, and also
13 that Blue referred to Woffinden as an "impostor" and as a "fake," Defendant's Opposition at 13.
14 Currently before the Court is Blue's motion to strike and dismiss several of Woffinden's counterclaims,
15 as well as Blue's motion for sanctions, which Blue argues are necessary because Woffinden failed to
16 consent to the filing of an amended complaint but later did not oppose Blue's motion for leave to amend.

LEGAL STANDARD

I. Motion to strike

20 The California Anti-SLAPP statute permits defendants to bring a “special motion to strike” if
21 a cause of action against them arises “from any act . . . in furtherance of the . . . right of petition or free
22 speech . . . in connection with a public issue,” unless “the plaintiff has established that there is a
23 probability that the plaintiff will prevail on the claim.” Cal. Civ. Proc. Code § 425.16(b)(1). If a
24 defendant prevails in bringing a motion to strike, that defendant “shall be entitled to recover his or her
25 attorney’s fees and costs.” *Id.* § 425.16(c). Although it is a state statute, California’s Anti-SLAPP
26 protections apply to state law claims brought in federal court. *See U.S. ex rel. Newsham v. Lockheed*
27 *Missiles & Space Co.*, 190 F.3d 963, 971-73 (9th Cir. 1999).

II. Motion to dismiss

Under Federal Rule of Civil Procedure 12(b)(6), a district court must dismiss a complaint if it fails to state a claim upon which relief can be granted. The question presented by a motion to dismiss is not whether the plaintiff will prevail in the action, but whether the plaintiff is entitled to offer evidence in support of the claim. *See Scheuer v. Rhodes*, 416 U.S. 232, 236 (1974), *overruled on other grounds by Davis v. Scherer*, 468 U.S. 183 (1984).

In answering this question, the Court must assume that the plaintiff's allegations are true and must draw all reasonable inferences in the plaintiff's favor. *See Usher v. City of Los Angeles*, 828 F.2d 556, 561 (9th Cir. 1987). Even if the face of the pleadings suggests that the chance of recovery is remote, the Court must allow the plaintiff to develop the case at this stage of the proceedings. *See United States v. City of Redwood City*, 640 F.2d 963, 966 (9th Cir. 1981).

If the Court dismisses the complaint, it must then decide whether to grant leave to amend. The Ninth Circuit has “repeatedly held that a district court should grant leave to amend even if no request to amend the pleading was made, unless it determines that the pleading could not possibly be cured by the allegation of other facts.” *Lopez v. Smith*, 203 F.3d 1122, 1130 (9th Cir. 2000) (citations and internal quotation marks omitted).

DISCUSSION

I. Blue's motion to strike Woffinden's fifth counterclaim

Plaintiff and counterclaim defendant Blue moves to strike defendant Woffinden’s fifth counterclaim pursuant to California’s Anti-SLAPP statute. Woffinden’s fifth counterclaim alleges liability for outrage based on Internet postings in which Blue allegedly slandered and libeled Woffinden, including one instance in which Blue may have called Woffinden a “twat.” Counterclaim at ¶ 17. In her opposition to Blue’s motion to dismiss, Woffinden contends that the fifth counterclaim is actually a claim for defamation and that the defamation is not limited to Blue’s use of the word “twat” but also includes Blue’s reference to Woffinden as a “fake” and as an “impostor.” *See* Defendant’s Opposition at 11-14.

California's Anti-SLAPP statute was enacted to quash lawsuits "brought primarily to chill the exercise of First Amendment freedoms by discouraging individuals from raising constitutionally protected issues through the legal process."

1 valid exercise of the constitutional rights of freedom of speech and petition for the redress of
2 grievances.” Cal. Civ. Proc. Code § 425.16(a); *see also Seelig v. Infinity Broad. Corp.*, 97 Cal. App.
3 4th 798, 806 (Cal. Ct. App. 2002) (“The goal is to eliminate meritless or retaliatory litigation at an early
4 stage of the proceedings.”). California courts have clarified that “[t]he statutory language establishes
5 a two-part test.” *Seelig*, 97 Cal. App. 4th at 806. First, courts “determine whether plaintiff’s causes of
6 action arose from acts by defendants in furtherance of defendants’ rights of petition or free speech in
7 connection with a public issue.” *Id.* at 806-07. This is a “threshold condition” to granting a motion to
8 strike under the statute. *Id.* at 807.

9 The statute defines an act in furtherance of the right of petition or free speech as, *inter alia*, “any
10 written or oral statement or writing made before a legislative, executive, or judicial proceeding,” “any
11 written or oral statement or writing made in a place open to the public or a public forum in connection
12 with an issue of public interest,” or “any other conduct in furtherance of the exercise of the
13 constitutional right of petition or . . . free speech in connection with a public issue or an issue of public
14 interest.” Cal. Civ. Proc. Code § 425.16(e). The requirement that the offending comments must have
15 been made “in connection with an issue of public interest” should be “‘construed broadly’ so as to
16 encourage participation by all segments of our society in vigorous public debate related to issues of
17 public interest.” *Seelig*, 97 Cal. App. 4th at 808 (quoting § 425.16(a)). Accordingly, California courts
18 have explained that the public interest requirement can be met where “private conduct [] impacts a broad
19 segment of society and/or . . . affects a community in a manner similar to that of a governmental entity.”
20 *Du Charme v. Int’l Bhd. of Elec. Workers*, 110 Cal. App. 4th 107, 115 (Cal. Ct. App. 2003) (internal
21 quotation marks omitted). In the latter situation, “where the issue is not of interest to the public at large,
22 but rather to a limited, but definable portion of the public . . . the constitutionally protected activity must,
23 at a minimum, occur in the context of an ongoing controversy, dispute or discussion, such that it
24 warrants protection by a statute that embodies the public policy of encouraging participation in matters
25 of public significance.” *Id.* at 119.

26 If a defendant can satisfy the first step, courts “then determine whether plaintiff has established
27 a reasonable probability that she will prevail on her claims at trial.” *Seelig*, 97 Cal. App. 4th at 807.
28 In order to survive the motion to strike, a plaintiff must “make a *prima facie* showing . . . of facts, which,

1 if proved at trial, would support a judgment in her favor.” *Id.*

2 Here, Blue argues that she meets the threshold condition and that Woffinden cannot make a
3 showing that she will likely prevail on her counterclaim at trial. Woffinden argues in response that the
4 dispute over her use of the name “Violet Blue” was not an issue of public interest at the time Blue made
5 the statements at issue in the fifth counterclaim, and that even if it were an issue of public interest,
6 Woffinden can satisfy the second step of the Anti-SLAPP test.

7 As to the threshold step, the parties appear to agree that Blue’s online statements about
8 Woffinden were written statements that were “made in a place open to the public or a public forum.”
9 The Court agrees that Blue’s website is a public forum for purposes of the Anti-SLAPP statute. *See,*
10 *e.g.*, *Kronemyer v. Internet Movie Data Base, Inc.*, 150 Cal. App. 4th 941, 950 (Cal. Ct. App. 2007).
11 Thus, the only dispute in the first step is whether Blue’s statements were made “in connection with an
12 issue of public interest.” Cal. Civ. Proc. Code § 425.16(e)(3). Blue first argued that the “twat”
13 statement was made in connection with an issue of public interest because the trademark dispute
14 between Blue and Woffinden is a public dispute that has been reported in many news articles directed
15 to the adult film industry and the technology sector. In response, Woffinden argues that the media
16 interest cited by Blue did not occur until after Blue filed her lawsuit against Woffinden, triggering any
17 public interest in their dispute that might exist. The Court agrees.

18 California Courts applying the Anti-SLAPP statute have been careful to look at the time period
19 in which the statements were made to determine whether they were connected to an issue of public
20 interest. *See, e.g.*, *Du Charme*, 110 Cal. App. 4th at 118 (employee’s termination was no longer a
21 current debate or controversy at the time statements were posted on the Internet); *People ex rel. 20th*
22 *Century Ins. Co. v. Building Permit Consultants*, 86 Cal. App. 4th 280, 285 (Cal. Ct. App. 2000)
23 (statements were not made in connection with a judicial proceeding for purposes of § 425.16(e)(2)
24 because at the time they were made there was no “issue under consideration” by any official
25 proceeding). According to Woffinden, Blue made the statements that form the basis of the fifth
26 counterclaim on October 27, 2006, and did not file suit against Woffinden until one year later, in
27 October 2007. All of the articles and blogs cited by Blue were not published until October 2007 or later,
28 and many of them reference the lawsuit itself. Although this later media attention indicates that the

1 trademark and name dispute between Blue and Woffinden may be a matter of public interest at this time,
2 it in no way indicates that it was a matter of public interest in October 2006.

3 In response to this argument, Blue contends that the trademark and name dispute was a matter
4 of public interest in the years leading up to Blue's October 2006 statements about Woffinden. Blue
5 contends that (1) both she and Woffinden are public figures; (2) Woffinden had invited Blue to appear
6 on Woffinden's radio talk show at some point "years ago"; (3) Woffinden won an adult video award for
7 "Best New Starlet" in 2002 under the name "Violet Blue"; (4) prior to October 2006, Woffinden agreed
8 to appear at San Francisco's Exotic Erotic Ball under the name "Violet Blue," and asked that she be
9 identified as "porn star Violet Blue" to avoid confusion; and (5) Woffinden had recognized that there
10 was confusion about the two of them prior to the filing of the lawsuit in 2007. *See Plaintiff's Reply at*
11 2, 4-5. Although these arguments establish that Blue and Woffinden both may be public figures, that
12 both used the name "Violet Blue," and that both were aware of each other's use of the name "Violet
13 Blue" prior to October 2006, they provide no evidence that the dispute between Blue and Woffinden
14 over the use of the name was of interest to more than a handful of members of the public. *See Rivero*
15 *v. Am. Fed'n of State, County, and Mun. Employees, AFL-CIO*, 105 Cal. App. 4th 913, 924, 926 (Cal.
16 Ct. App. 2003) (court denied motion to strike where the only people involved in the dispute were a
17 supervisor and eight employees, and noted that publication on the Internet does not turn private
18 information into a matter of public interest); *cf. Seelig*, 97 Cal. App. 4th at 807 (public interest
19 requirement met where plaintiff appeared on a television show that "generated considerable debate
20 within the media"). To the contrary, all these arguments suggest is that Blue and Woffinden had
21 contacted each other privately in an effort to address any confusion of their names. Even assuming
22 some members of the populace paid attention to both Blue's writings and the pornography industry, and
23 that a subset of these aficionados mistakenly believed that plaintiff Blue had starred in adult films or
24 would appear at the Exotic Erotic Ball, such belief does not by itself demonstrate that the confusion, or
25 the dispute surrounding the confusion, was a matter of public interest. Indeed, the mistaken members
26 of the public may not have even been aware that Blue and Woffinden were two different people. The
27 California courts have made clear that "judges and attorneys will, or should, know a public concern
28 when they see it," *Du Charme*, 110 Cal. App. 4th at 117, and this Court simply does not see how this

1 dispute – if it even amounted to a dispute at that time – was a public concern in October 2006.
2 Additional evidence would surely be required, such as the evidence Blue put forth regarding the interest
3 of the public from October 2007 onward.

4 The Court also finds it necessary to address an argument raised by Blue for the first time at the
5 hearing. Blue suggested that a statement made “in connection with an issue of public interest,” Cal. Civ.
6 Proc. Code § 425.16(e)(3), can be any statement that pertains to a public figure. In support of this
7 contention, Blue cited *Du Charme*, which notes, without citation or support, that “the majority of cases
8 . . . involve statements made in connection with a topic, *person* or entity of *widespread* public interest.”
9 *Du Charme*, 110 Cal. App. 4th at 117 (first emphasis added). The Court notes that this dicta is not
10 supported by the plain language of the statute, which specifies that it applies to “matters of public
11 interest,” Cal. Civ. Proc. Code § 425.16(a), a “public issue,” *id.* § 425.16(b)(1), and “an issue of public
12 interest,” *id.* § 425.16(e)(3). Missing from the statute is any indication that it applies to people of public
13 interest or public figures absent an issue of public interest. That said, the *Du Charme* court’s statement
14 that the public interest requirement may be satisfied merely through some connection to a person of
15 public interest appears to have some support in the caselaw. In *Nygård, Inc. v. Uusi-Kerttula*, 159 Cal.
16 App. 4th 1027 (Cal. Ct. App. 2008), the California Court of Appeal explained that the definition of
17 public interest is to be construed broadly, and thus that “the issue need not be ‘significant’ to be
18 protected by the anti-SLAPP statute – it is enough that it is one in which the public takes an interest,”
19 *id.* at 1042. The court went on to hold that a magazine article about a Finnish businessman and celebrity
20 concerned an issue of public interest because there was “‘extensive interest’ in Nygård . . . among the
21 Finnish public” and because there was “particular interest among the magazine’s readership in
22 ‘information having to do with Mr. Nygård’s famous Bahamas residence which has been the subject of
23 much publicity in Finland.’” *Id.*; *see also Sipple v. Found. for Nat’l Progress*, 71 Cal. App. 4th 226
24 (Cal. Ct. App. 1999). With all due respect to the parties before the Court, that level of “extensive
25 interest,” *Nygård*, 159 Cal. App. 4th at 1042, or “widespread” interest, *Du Charme*, 110 Cal. App. 4th
26 at 117, in Blue or Woffinden has not been shown.

27 For these reasons, the Court finds that counterclaim defendant Blue has not satisfied the first
28 prong of the Anti-SLAPP statute, and thus the Court need not determine Woffinden’s likelihood of

1 success under the second prong. Blue's motion to strike the fifth counterclaim is DENIED. However,
2 the Court does have concerns about Woffinden's fifth counterclaim. First, the counterclaim is, by its
3 plain language, a claim for outrage, so to the extent Woffinden wishes to bring a claim for defamation
4 instead, she must amend her complaint to make that clear. Because the Court can foresee no prejudice
5 to Blue, the Court grants Woffinden leave to do so. Second, if Woffinden chooses to amend her
6 counterclaim to state a claim for defamation, she should consider how the First Amendment might affect
7 her claim. *See Phila. Newspapers, Inc. v. Hepps*, 475 U.S. 767, 772-75 (1986); *Dworkin v. Hustler*
8 *Magazine Inc.*, 867 F.2d 1188, 1196-97 (9th Cir. 1989).

9

10 **II. Blue's motion to dismiss Woffinden's third counterclaim**

11 Woffinden's third counterclaim asks the Court to cancel Blue's federal trademark registration.
12 Blue initially moved to dismiss this counterclaim for failure to state a claim, because at the time the
13 counterclaim was filed, Blue's trademark application was pending and was not a registered trademark
14 that was capable of being cancelled under the statute. *See* 15 U.S.C. §§ 1119, 1127. Since the filing
15 of Blue's motion to dismiss, however, the United States Patent and Trademark Office issued the
16 registration for Blue's trademark. Woffinden argues that this development moots Blue's motion to
17 dismiss, and Blue agrees. The Court therefore DENIES AS MOOT Blue's motion to dismiss
18 Woffinden's third counterclaim.

19

20 **III. Blue's motion to dismiss Woffinden's fourth counterclaim**

21 Woffinden's fourth counterclaim appears to allege that Blue has infringed Woffinden's
22 unregistered trademark. Blue argues that this counterclaim must be dismissed without leave to amend
23 because Woffinden fails to allege that "Violet Blue" is a protectable unregistered trademark or that
24 Woffinden has been damaged. More importantly, Blue argues the counterclaim must be dismissed
25 because Woffinden has expressly denied that there is any likelihood of confusion between herself and
26 Blue.

27 Woffinden's fourth counterclaim presumably arises under § 43(a) of the Lanham Act, which
28 provides a cause of action for infringement of an unregistered trademark. *Two Pesos, Inc. v. Taco*

1 *Cabana, Inc.*, 505 U.S. 763, 768 (1992) (noting that “it is common ground that § 43(a) protects
2 qualifying unregistered trademarks”). To state a claim under § 43(a), Woffinden must allege that her
3 stage name “Violet Blue” is distinctive and that Blue’s use of the name creates a likelihood of
4 confusion.¹ *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 (9th Cir. 1998).
5 “Likelihood of confusion exists when customers viewing the mark would probably assume that the
6 product or service it represents is associated with the source of a different product or service identified
7 by a similar mark.” *Id.* at 1048 (internal quotation marks omitted).

8 Woffinden concedes that her fourth counterclaim requires amendment to include further
9 allegations necessary to state a claim for infringement, and asks the Court to grant her leave to amend.
10 Blue argues in response that no leave to amend should be granted because any amendment would be
11 futile given the inconsistencies in Woffinden’s pleadings. Blue argues, and the Court agrees, that
12 Woffinden’s pleadings unambiguously state that there has been no confusion between Blue and
13 Woffinden. *See, e.g.*, Defendant’s Answer at 23, ¶ 24 (“Plaintiffs [sic] cannot establish its [sic] claims
14 of trademark infringement and unfair competition claims as the parties have co-existed with their
15 respective uses of the name ‘Violet Blue’ for many years without confusion.”). This is certainly
16 inconsistent with the argument inherent in her counterclaim that there is a likelihood of confusion
17 between the two.

18 The Federal Rules of Civil Procedure permit a party to “state as many separate claims or
19 defenses as it has, regardless of consistency.” Fed. R. Civ. P. 8(d)(3). The Seventh Circuit has clarified,
20 however, that in light of Rule 11, “a pleader may assert contradictory statements of fact only when
21 legitimately in doubt about the facts in question.” *Am. Int’l Adjustment Co. v. Galvin*, 86 F.3d 1455,
22 1461 (7th Cir. 1996); *see also* 5 Wright and Miller, Federal Practice and Procedure § 1285 (3d ed.
23 2004). The Ninth Circuit has indicated its approval of this limitation on inconsistent pleadings, *Total
24 Coverage, Inc. v. Cendant Settlement Servs. Group*, 252 Fed. Appx. 123, *3 (9th Cir. July 3, 2007), and
25 this Court agrees. Therefore, Woffinden will be granted leave to amend her fourth counterclaim, but
26 in doing so must adhere carefully to the requirements of Rule 11 and must conduct a reasonable inquiry

27
28 ¹An additional element is “nonfunctionality,” *Kendall-Jackson Winery*, 150 F.3d at 1047, but
functionality is not at issue here.

1 to determine whether she is legitimately in doubt about the likelihood of confusion. Absent legitimate
2 doubt, the Court will not look favorably upon such amendment.

3

4 **IV. Blue's motion for sanctions**

5 Finally, plaintiff Blue moves for sanctions against Woffinden because Woffinden first declined
6 to consent to the filing of Blue's amended complaint and later filed a notice of non-opposition to Blue's
7 motion for leave to file an amended complaint. Because there is no evidence that Woffinden's counsel
8 acted in bad faith, the Court DENIES the motion for sanctions. That said, the Court acknowledge's
9 Blue's concern about the potential for future gamesmanship by Woffinden's counsel, and notes that
10 repeated instances of similar behavior should be avoided. The Court also DENIES Woffinden's motion
11 for sanctions and motion to strike any suggestions in Blue's motion that Woffinden's counsel engaged
12 in delay tactics.

13

14

CONCLUSION

15 For the foregoing reasons and for good cause shown, the Court hereby DENIES Blue's motion
16 to strike the fifth counterclaim, DENIES AS MOOT Blue's motion to dismiss the third counterclaim,
17 and GRANTS WITH LEAVE TO AMEND Blue's motion to dismiss the fourth counterclaim [Docket
18 No. 42]. The Court also DENIES Blue's motion for sanctions, and DENIES Woffinden's motion for
19 sanctions and motion to strike [Docket Nos. 23, 41, 61].

20

21

IT IS SO ORDERED.

22

23 Dated: April 7, 2008

24

25

26

27

28



SUSAN ILLSTON
United States District Judge